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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,987	10/15/2008	Yusuke Nakamura	082368-008500US	7942
20350 7590 03/28/2011 KILPATRICK TOWNSEND & STOCKTON LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER HOLLERAN, ANNE L	
			ART UNIT 1643	PAPER NUMBER
			NOTIFICATION DATE 03/28/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/586,987	Applicant(s) NAKAMURA ET AL.	
	Examiner ANNE HOLLERAN	Art Unit 1643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1643

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16, drawn to methods and kits for measuring methyl transferase activity of a polypeptide comprising the amino acid sequence of SEQ ID NO: 51, or variants of SEQ ID NO: 51, where the variant may comprise any substitution, deletion, insertion of one or more amino acids.

Group II, claim(s) 17, drawn to a composition comprising a pharmaceutically effective amount of a compound that decreases ZNFN3A1-mediated methylation.

Group III, claim(s) 18, drawn to a method of treating colorectal cancer or hepatocellular carcinoma, comprising administering a composition comprising a pharmaceutically effective amount of a compound that decreases ZNFN3A—mediated methylation.

Group IV, claim(s) 19, drawn to a method of treating colorectal cancer or hepatocellular carcinoma, comprising administering a composition comprising a pharmaceutically effective amount of a compound that decreases an interaction between ZNFN3A1 and HSP90A.

Group V, claim(s) 20, drawn to a method of treating colorectal cancer or hepatocellular carcinoma, comprising contacting a colorectal cancer cell or a hepatocellular carcinoma cell with a pharmaceutically effective amount of a compound that decreases an interaction between ZNFN3A1 and S-adenosyl-L-methionine.

The groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

For group I, the technical feature is that of polypeptide having methyl transferase activity.

For groups II and III, the technical feature is that of a compound that decreases ZNFN3A1-mediated methylation.

Art Unit: 1643

For group IV the technical feature is that of a compound that decrease an interaction between ZNFN3A1 and HSP90A.

For group V the technical feature is that of a compound that decrease an interaction between ZNFN3A1 and S-adenysyl-L-methionine.

Group I does not share a technical feature with any of groups II-V. Therefore, group I does not share the same or corresponding special technical feature with any of groups II-V.

The technical feature of groups II and III that is in common is that of a compound that decreases ZNFN3A1-mediated methylation. However, the characterization of a compound in functional terms does not allow one to compare with the prior art, because while this function may be an inherent function of the compound, the compound itself may be known in the prior art but not as having this function. Additionally, the prior art teaches compounds methods for screening of compounds to find those that modulate histone methyltransferase activity (see WO 02/092002, page 2, paragraph 12-20; cited in the IDS). Therefore, compounds that decrease ZNFN3A1-mediated methylation as broadly claimed in the instant application are known in the art. Thus, compounds that decrease ZNFN3A1-mediated methylation do not make a contribution over the prior art as a whole, and cannot be considered a special technical feature that links groups II and III.

Group IV does not share a technical feature with any of groups I-III or V. Therefore, group IV does not share the same or corresponding special technical feature with any of groups I-III and V.

Group V does not share a technical feature with any of groups I-IV. Therefore, group V does not share the same or corresponding special technical feature with any of groups I-IV.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

In re Ochiai:

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found

Art Unit: 1643

allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Holleran, whose telephone number is (571) 272-0833. The examiner can normally be reached on Monday through Friday from 9:30 am to 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Misook

Art Unit: 1643

Yu, can be reached on (571) 272-0839. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Official Fax number for Group 1600 is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Anne L. Holleran
Patent Examiner

/Alana M Harris, Ph.D./
Primary Examiner, Art Unit 1643